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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,197	04/14/2006	Craig Duncan Webster	920602-100935	5650
23644 7590 04/07/2008 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER				
LOW, LINDSAY M				
ART UNIT		PAPER NUMBER		
3721				
NOTIFICATION DATE		DELIVERY MODE		
04/07/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

Office Action Summary

Application No.

10/560,197

Applicant(s)

WEBSTER, CRAIG DUNCAN

Examiner

LINDSAY M. LOW

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-53 and 59-66 is/are rejected.
- 7) ☒ Claim(s) 54-58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment received on December 27th, 2007.

Drawings

2. The drawings were received on December 27th, 2007. These drawings are accepted.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 46-53 and 59-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding the amendments to the claims, the deletion of the "angular displacement" is deemed an intent to exclude the rotation of the chuck being dependent upon an "angular displacement and/or angular velocity" of the handwheel from the claimed invention and is considered new matter as it is not supported by the original disclosure. The disclosure states that the chuck is rotated based on the "angular displacement and/or the angular velocity" of the

handwheel and not the angular velocity only. Even though the claims are in "comprising" format, it is clear that the deletion is intended to read over the Miller, Gilmore, and Horner references.

112 6th Paragraph

5. Regarding paragraph 5 of the previous office action mailed September 27th, 2007, it should be noted that this is neither a rejection nor an objection to the claims. The paragraph is used to establish how the examiner is interpreting the "means" recitation. To invoke 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines; or (B) show that even though the phrase "means for" or "step for" is not used, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112, sixth paragraph (MPEP 2181). In other words, applicant's claims do not explicitly use the term "for," which is required in the first prong of the 3-prong test in order to invoke 35 U.S.C. 112, sixth paragraph. Therefore, applicant either needs to put the claims in proper format or be clear about invoking 112 sixth paragraph if the applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph. Hereinafter, it is assumed that the claims do NOT invoke 35 U.S.C. 112, sixth paragraph.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 46-52, 59-60 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (5,948,030) and Admitted Prior Art for the same reasons set forth in paragraph 7 of the previous office action, *supra*.

Regarding the amendments to the claims, it should be noted that 35 U.S.C. 112, sixth paragraph is NOT invoked. Therefore, the claimed invention is not restrictive to the functional recitations of the sensor and control means. The first sensor means and first control means are deemed capable of performing the same recited function of sensing the angular velocity of the handwheel since the reference to Miller discloses parts that can be programmed to perform the recited functions.

Miller is silent about having a chuck in the handwheel-operated device. However, these features are admitted prior art since Applicant has not adequately traversed the obviousness of such features, i.e. Applicant has not pointed out the specific reason why they are not obvious. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a chuck so as to secure Miller's wheel to the steering knuckle while allowing it to rotate in response to the handwheel 26.

8. Claims 46-50, 52-53, 59, and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore (2002/0153856. See U.S. Patent equivalent 6,836,614) in view of Horner (3,120,845) for the same reasons set forth in paragraph 8 of the previous office action, *supra*.

Regarding the amendments to the claims, it should be noted that 35 U.S.C. 112, sixth paragraph is NOT invoked. Therefore, the claimed invention is not restrictive to the functional recitations of the sensor and control means. The first sensor means and first control means are deemed capable of performing the same recited function of sensing the angular velocity of the handwheel since the modified device of Gilmore discloses parts that can be programmed to perform the recited functions.

9. Claims 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilmore (2002/0153856. See U.S. Patent equivalent 6,836,614) in view of Horner (3,120,845). as applied to claims 46-50, 52-53, 59, and 64-66 above, and further in view of Tomiser (4,811,623) for the same reasons set forth in paragraph 9 of the previous office action, *supra*.

Allowable Subject Matter

10. Claims 54-58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed December 27th, 2007 have been fully considered but they are not persuasive.

Applicant contends that there is no motivation to modify the teaching of Miller and Gilmore's modified device to use the angular velocity of the handwheel because Miller

and the modified device of Gilmore deal with angular displacement instead. However, as stated in the above rejection, both devices have a control system that is capable of sensing the angular velocity of the handwheel (or modified handwheel) in order to rotate the chuck because they both disclose the necessary elements to perform that function.

Applicant contends that Horner's handwheel is not used for the same purpose as the applicants. However, although it is acknowledged that Horner uses the handwheel 49 for when a bit may become stuck or when the motor fails, Horner's handwheel can also be used in place of the motor to drive the chuck (see col. 2 lines 45-57). Therefore, Horner's handwheel can be used for the same purpose of driving the chuck in a power tool.

For the reasons above, the grounds of rejection are deemed proper.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY M. LOW whose telephone number is (571)272-1196. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. M. L./
Examiner, Art Unit 3721

/Rinaldi I Rada/
Supervisory Patent Examiner, Art Unit 3721
3/31/2008